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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,833	09/19/2003	Bruno Borsoi	P24138	4888

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,833	Applicant(s) BORSOI, BRUNO	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12182003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 3-5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/37782 (WO '782). WO '782 discloses all the limitations of the claims including the following: a sole (portion skate wheels is mounted to) and an upper 14, 12); the boot extending longitudinally between a heel and a tip (see Figure 1); the upper including an outer envelope 12 and an inner envelope 14; a mechanism 20, 18, 24 for tightening the inner envelope; the mechanism for tightening the inner envelope including keepers 24 affixed to the inner envelope and at least one lace 20; the mechanism for tightening the inner envelope further including at least one rear keeper 18 affixed to the outer envelope; the rear keeper being located substantially in an area of the heel of the boot (see Figure 3); the outer envelope and the inner envelope are connected to one another by respective bases (when inner envelope is inserted in outer envelope as shown in Figure 1); the inner envelope is a liner mounted within the outer envelope (see Figure 1); the at least one rear keeper 18 comprises two rear keepers; one of the two rear keepers

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being located on the lateral side on the lateral quarter of the outer envelope (see Figure 3); another of the two rear keepers being located on the medial side on the medial quarter of the outer envelope (see Figure 3); the upper includes a lower portion provided to surround the foot and an upper portion provided to surround a portion of a user's lower leg (see Figure 1).

3. Claims 1, 3-5 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Basso et al. 6,405,457. Basso et al. '457 discloses all the limitations of the claims including the following: a sole 12 and an upper 20, 30; the boot extending longitudinally between a heel and a tip (see Figure 1); the upper including an outer envelope 30 and an inner envelope 20; a mechanism 25, 26, 55 for tightening the inner envelope; the mechanism for tightening the inner envelope including keepers 25 affixed to the inner envelope and at least one lace 26; the mechanism for tightening the inner envelope further including at least one rear keeper 55 affixed to the outer envelope; the rear keeper being located substantially in an area of the heel of the boot (see Figure 2); the outer envelope 30 and the inner envelope 20 are connected to one another by respective bases (bottom portions of each envelope); the inner envelope 20 is a liner mounted within the outer envelope (see Figure 1); the at least one rear keeper 55 comprises two rear keepers; one of the two rear keepers being located on the lateral side on the lateral quarter of the outer envelope (see Figure 2); another of the two rear keepers being located on the medial side on the medial quarter of the outer envelope (see Figure 2); the upper includes a lower portion provided to surround the foot and an upper portion provided to surround a portion of a user's lower leg (see Figure 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being obvious over WO 98/37782 as applied to claim 1 above. WO '782 discloses all the limitations of the claims except for the location of the straps used to make the keepers. WO '782 teaches that keepers, such as that shown as 22, can be made of straps that are made into loops by being folded. WO '782 also teaches that the keepers on the outer envelope can be located above the heel and forward of the heel (see 18 near 22 in Figure 1). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the keepers on the outer envelope of the shoe of WO '782 out of straps folded over to form loops and mounted on the outer envelope forward and above the heel to allow for greater adjustability of the tightness or looseness of the outer envelope due to the length of the straps.

6. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basso et al. 6,405,457 as applied to claim 1 above in view of Barret 5,940,990. Basso et al. '457 discloses all the limitations of the claims except or the keepers being made of straps folded over to form loops. Barret '990 teaches that keepers 36 can be formed of straps that are folded over to form loops. These keepers can be located in front of and above the heel of the shoe. The extra length of the straps would allow for more versatility in the tightening of the boot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make

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the keepers of the boot of Basso et al. '457 out of folded over straps, as taught by Barret '990, to allow for more adjustability for the tightening of the boot to the user's foot.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of the reference as applied to claim 1 above in view of Maccano 4,822,500. Each of the references as applied to claim 1 above discloses all the limitations of the claim except for an insole being affixed to the bases of the envelopes. Maccano '500 teaches that an insole can be located within the inside of a shoe and abut against the base of the envelopes of the upper of the shoe to give support to the user's foot and aid in cushioning the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an insole within the boot of either of the references as applied to claim 1 above, to give the user's foot support and cushioning.

Conclusion

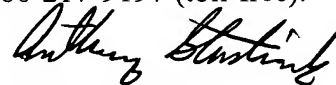
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS